

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Patrick Miles, et al. Art Unit: 3762  
Serial No.: 10/789,797 Examiner: Christopher A. Flory  
371(c) Date: February 27, 2004  
Title: Surgical Access System and Related Methods

---

**Certificate of Transmission:** I hereby certify that this correspondence is being transmitted to the USPTO via EFS-Web on December 5, 2008:

Signature: /jaybell/  
Name: Jay Bell

**RENEWED PETITION UNDER 37 CFR § 1.137(b)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir or Madam:

This paper is in response to a Decision on Petition mailed on August 20, 2008 ("Decision"), in which the Applicant's Petition for Revival of an Application for Patent Abandoned for Failure to Notify the Office of a Foreign or International Filing under 37 CFR 1.137(f) was DISMISSED. In the Decision, the Applicant was invited to respond in the form of a Renewed Petition under 37 CFR 1.137(b). The Applicant's response is set forth below.

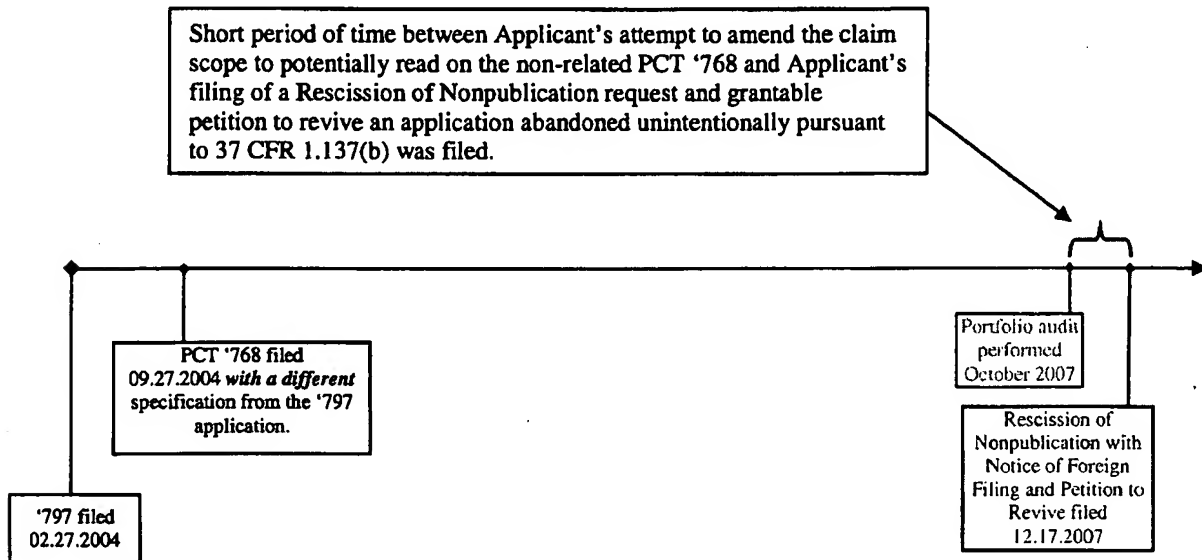
As an initial matter, it is noted that in December 2007 the Applicant filed two separate Petitions for Revival of the above-captioned US Patent Application No. 10/789,797. First, on **December 17, 2007**, the Applicant filed a Petition for Revival of an Application for Patent Abandoned for Failure to Notify the Office of a Foreign or International Filing under 37 CFR 1.137(f) ("First Petition"). The need for this First Petition arose only after Applicant attempted to amend the claim scope to a form that could possibly read upon a non-related foreign application with a *different* specification. Second, on **December 31, 2007**, the Applicant filed a Petition for Revival of an Application Abandoned Unintentionally under 37 CFR 1.137(b)

("Second Petition"). This Second Petition arose only after the Applicant discovered that the present application was not properly associated with Applicant's Customer Number, thereby preventing the Applicant from receiving notification of the Office Action. The Applicant respectfully asserts that the Petitions as submitted are grantable, and furthermore requests that prosecution of the '797 application be reinstated without delay. The earlier Decision appears to be directed primarily at the First Petition. Furthermore, it does not appear that the Applicant ever received a decision on the Second Petition, nor was the accompanying amendment ever entered. For the sake of clarity, each Petition (and cause of abandonment) will be considered separately in this Renewed Petition.

#### **I. First Petition**

The instant '797 application, filed on February 27, 2004, is drawn to a surgical retraction system. At the time of filing, there were no foreign or international counterpart applications (i.e. applications claiming priority to the instant application) on file, and furthermore the Applicant did not contemplate filing such an application. Consequently, the Applicant filed a Request for Non-Publication under 35 USC 122(b)(2)(B)(i). On September 27, 2004, the Applicant filed PCT Application No. PCT/2004/031768, which is an **unrelated co-owned application with a different specification** (claiming benefit of priority from U.S. Patent Application No. 11/137,169). The '768 PCT application discloses a somewhat different surgical retraction system, and includes a different specification and different drawing set. At the time of filing the '768 PCT application, the Applicant believed that the retraction system disclosed therein was sufficiently different from the retraction system disclosed in the instant '797 application such that a Rescission of the previous Nonpublication Request and corresponding Notice of Foreign Filing was not required.

### **Timeline I – Rescission of Nonpublication Request**



As shown in the Timeline I (above), the Applicant performed an internal audit of its patent portfolio in October 2007 to prepare for the proposed PTO rules changes that were to take effect on November 1, 2007. As part of this audit, the Applicant decided to amend the claim scope of the instant application in order to seek protection for some specific embodiments. The Applicant thereafter determined that the amended claim scope could potentially overlap with some of the claims of the '768 PCT application (even though the '768 PCT application has a different specification). Thus, as a result of this attempt to change the claim scope in the '797 application, the Applicant decided to rescind the nonpublication request of the present application (in an abundance of caution) in light of the potential overlap of claimed subject matter with the '768 PCT application. However, prior to this attempt to amend the claim scope there was no need for the Applicant to rescind the nonpublication request because the '768 PCT application provided a different specification and claimed different embodiments. Applicant filed the claim amendment on December 31, 2007 (see below), but it does not appear to have been entered.

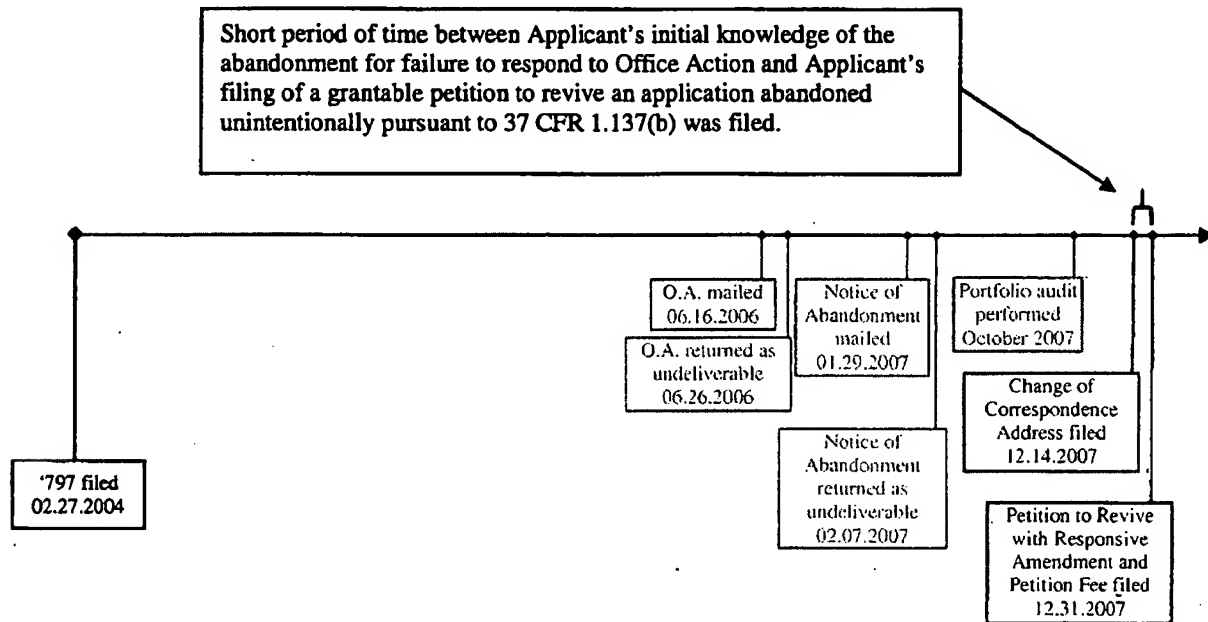
The Applicant respectfully submits that the submission of December 17, 2007 constitutes a grantable petition under 37 CFR 1.137(f). At the time of filing the '768 PCT application, there was no reason for the Applicant to rescind the nonpublication request in the instant application.

The reason (if any) to rescind the nonpublication request arose no earlier than the October 2007 portfolio audit and resultant strategy to change the claim scope in the '797 application. Thus, the Applicant respectfully submits that this short period of 2-3 months (between the October 2007 portfolio audit and the December 17, 2007 petition) was not a substantial delay—and certainly less than the 3.5 years alleged by the August 20, 2008 Decision. Thus, the Applicant respectfully requests that this Renewed Petition be granted so that prosecution on the merits may continue without further delay.

## II. Second Petition

The portfolio audit in late 2007 also uncovered a PTO clerical error that unknowingly caused the instant application to be abandoned for failure to respond to an Office Action mailed June 16, 2006 ("Office Action"). The relevant facts explaining the non-response are as follows. The instant application was filed on February 27, 2004. A review of the Utility Patent Application Transmittal form filed with the application reveals that the "Correspondence Address" information was correctly entered as "Customer Number 30,328." However, *due to apparent PTO error*, the application was not in fact associated with the Applicant's Customer Number at the time of filing. The Applicant was not aware of this PTO error, and furthermore had no reason to believe such an error existed until subsequent discovery in late 2007, as will be explained later. In January 2005 the Applicant relocated to a new address, and timely filed a Customer Number Data Change form to effectuate the change of address with the PTO. However, due to the fact that the instant application was not associated with the Applicant's Customer Number, the associated correspondence address was not changed. Thus, the Applicant did not receive the June 16, 2006 Office Action at any time during the period for response because it was mailed to an old address (and returned to the PTO as undeliverable). Subsequently, and for the same reason, the Applicant did not receive the Notice of Abandonment mailed January 29, 2007.

### **Timeline II – Failure to respond to Office Action**



As shown in TimeLine II (shown above), the PTO error related to the association of the Customer Number was discovered by the Applicant in the course of performing the portfolio audit in late 2007. Consequently, a Change of Correspondence Address was filed December 14, 2007. After the Correspondence Address was changed at the PTO, giving Applicant access to the application via Private PAIR, the Applicant finally discovered that the application had been abandoned for failure to respond to an Office Action. Thus, the Applicant was made aware of the June 16, 2006 Office Action no earlier than December 14, 2007 (the date of mailing of the Change of Correspondence Address form). On December 31, 2007, very shortly after becoming aware of the abandonment, the Applicant filed a Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b). As part of the Petition, the following items were submitted:

- (1) The required reply in the form of a Responsive Amendment;
- (2) The petition fee as set forth in 37 CFR 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition pursuant to 1.137(b) was unintentional.

The Applicant respectfully submits that the submission of December 31, 2007 constitutes a grantable petition under 37 CFR 1.137(b). Thus, the Applicant respectfully requests that the holding of Abandonment for failure to respond to an Office Action be withdrawn so that prosecution on the merits may continue without further delay.

### **III. Request for Reconsideration**

The Applicant respectfully requests reconsideration of the First and Second Petitions in accordance with this Renewed Petition under 37 CFR 1.137(b). No fees associated with this renewed petition are deemed necessary at this time. However, in the event that there are any additional fees to be charged or payments to be credited, the applicant hereby request that any charges or credits be made to Deposit Account No.: 502040 for Customer No.: 30328. In the event that there are any questions concerning the remarks above or the application in general, the Patent Office is cordially invited to telephone the undersigned attorney so that prosecution may be expedited.

Respectfully submitted,  
NUVASIVE, INC.

By: 

Jonathan Spangler, Esq.  
Registration No. 40,182

7475 Lusk Boulevard  
San Diego, CA 92121  
Tel.: (858) 243-0029

December 5, 2008